

# UTILITY PATENT APPLICATION TRANSMITTAL (Small Entity)

(Only for new nonprovisional applications under 37 CFR 1.53(b))

Docket No.  
A-8330.C

Total Pages in this Submission  
12

## TO THE COMMISSIONER FOR PATENTS

Mail Stop Patent Application  
P.O. Box 1450  
Alexandria, VA 22313-1450

Transmitted herewith for filing under 35 U.S.C. 111(a) and 37 C.F.R. 1.53(b) is a new utility patent application for an invention entitled:

**BIOINFORMATICAALLY DETECTABLE GROUP OF NOVEL REGULATORY GENES AND USES THEREOF**

and invented by:

**ITZHAK BENTWICH**

22387 U.S. PTO  
10/651227



08/29/03

If a **CONTINUATION APPLICATION**, check appropriate box and supply the requisite information:

☒ **Continuation** ☐ **Divisional** ☐ **Continuation-in-part (CIP)** of prior application No.: 10/310,914

Which is a:

☐ **Continuation** ☐ **Divisional** ☐ **Continuation-in-part (CIP)** of prior application No.: \_\_\_\_\_

Which is a:

☐ **Continuation** ☐ **Divisional** ☐ **Continuation-in-part (CIP)** of prior application No.: \_\_\_\_\_

Enclosed are:

### Application Elements

1. ☒ Filing fee as calculated and transmitted as described below
2. ☒ Specification having filed on CD-R disk pages and including the following:
  - a. ☐ Descriptive Title of the Invention
  - b. ☐ Cross References to Related Applications (if applicable)
  - c. ☐ Statement Regarding Federally-sponsored Research/Development (if applicable)
  - d. ☐ Reference to Sequence Listing, a Table, or a Computer Program Listing Appendix
  - e. ☐ Background of the Invention
  - f. ☐ Brief Summary of the Invention
  - g. ☐ Brief Description of the Drawings (if filed)
  - h. ☐ Detailed Description
  - i. ☐ Claim(s) as Classified Below
  - j. ☐ Abstract of the Disclosure

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## Application Elements (Continued)

3. ☐ Drawing(s) (when necessary as prescribed by 35 USC 113)
- a. ☐ Formal      Number of Sheets \_\_\_\_\_
- b. ☐ Informal      Number of Sheets \_\_\_\_\_
4. ☒ Oath or Declaration
- a. ☐ Newly executed (original or copy)      ☐ Unexecuted
- b. ☒ Copy from a prior application (37 CFR 1.63(d)) (for continuation/divisional application only)
- c. ☐ With Power of Attorney      ☐ Without Power of Attorney
- d. ☐ DELETION OF INVENTOR(S)  
Signed statement attached deleting inventor(s) named in the prior application,  
see 37 C.F.R. 1.63(d)(2) and 1.33(b).
5. ☒ Incorporation By Reference (usable if Box 4b is checked)  
The entire disclosure of the prior application, from which a copy of the oath or declaration is supplied under Box 4b, is considered as being part of the disclosure of the accompanying application and is hereby incorporated by reference therein.
6. ☒ CD ROM or CD-R in duplicate, large table or Computer Program (Appendix)
7. ☐ Application Data Sheet (See 37 CFR 1.76)
8. ☒ Nucleotide and/or Amino Acid Sequence Submission (if applicable, all must be included)
- a. ☒ Computer Readable Form (CFR)
- b. ☒ Specification Sequence Listing on:
- i. ☒ CD-ROM or CD-R (2 copies); or
- ii. ☐ Paper
- c. ☐ Statement(s) Verifying Identical Paper and Computer Readable Copy

## Accompanying Application Parts

9. ☐ Assignment Papers (cover sheet & document(s))
10. ☐ 37 CFR 3.73(B) Statement (when there is an assignee)
11. ☐ English Translation Document (if applicable)
12. ☐ Information Disclosure Statement/PTO-1449      ☐ Copies of IDS Citations
13. ☐ Preliminary Amendment
14. ☒ Return Receipt Postcard (MPEP 503) (Should be specifically itemized)
15. ☐ Certified Copy of Priority Document(s) (if foreign priority is claimed)
16. ☐ Certificate of Mailing
- ☐ First Class      ☐ Express Mail (Specify Label No.): \_\_\_\_\_

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**Accompanying Application Parts (Continued)**

17. ☒ Applicant claims small entity status. See 37 CFR 1.27.

☐ (Optional) Small Entity Statement(s) - Specify Number of Statements Submitted: \_\_\_\_\_

18. ☒ Additional Enclosures *(please identify below)*:

CD-R plus copy includes Specification, Tables and Sequence Listing (File Reference Number 50004)  
Patent Application Informational Letter  
Petition to Waive Requirement of Section 1.52(e)

**Request That Application Not Be Published Pursuant To 35 U.S.C. 122(b)(2)**

19. ☐ Pursuant to 35 U.S.C. 122(b)(2), Applicant hereby requests that this patent application not be published pursuant to 35 U.S.C. 122(b)(1). Applicant hereby certifies that the invention disclosed in this application has not and will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication of applications 18 months after filing of the application.

**Warning**

***An applicant who makes a request not to publish, but who subsequently files in a foreign country or under a multilateral international agreement specified in 35 U.S.C. 122(b)(2)(B)(i), must notify the Director of such filing not later than 45 days after the date of the filing of such foreign or international application. A failure of the applicant to provide such notice within the prescribed period shall result in the application being regarded as abandoned, unless it is shown to the satisfaction of the Director that the delay in submitting the notice was unintentional.***

08/29/03



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**Fee Calculation and Transmittal**

**CLAIMS AS FILED**

For	#Filed	#Allowed	#Extra	Rate	Fee
Total Claims	16	- 20 =	0	x \$9.00	\$0.00
Indep. Claims	5	- 3 =	2	x \$42.00	\$84.00
Multiple Dependent Claims (check if applicable) <input type="checkbox"/>					\$0.00
BASIC FEE					\$375.00
OTHER FEE (specify purpose) <u>Petition Fee</u>					\$130.00
TOTAL FILING FEE					\$589.00

- ☐ A check in the amount of \_\_\_\_\_ to cover the filing fee is enclosed.
- ☒ The Director is hereby authorized to charge and credit Deposit Account No. **502830** as described below.
- ☒ Charge the amount of \_\_\_\_\_ as filing fee.
- ☒ Credit any overpayment.
- ☒ Charge any additional filing fees required under 37 C.F.R. 1.16 and 1.17.
- ☐ Charge the issue fee set in 37 C.F.R. 1.18 at the mailing of the Notice of Allowance, pursuant to 37 C.F.R. 1.311(b).

Dated: August 29, 2003

Signature

Mitchell B. Wasson - Reg. 27,408  
Hoffman, Wasson & Gitler, P.C.  
2361 Jefferson Davis Highway  
Suite 522  
Arlington, VA 22202  
(703)415-0100

CC: 20741

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of

**Itzhak BENTWICH**

Serial No:

Group Art Unit:

Filed :

Examiner:

For : **BIOINFORMATIALLY DETECTABLE  
GROUP OF NOVEL REGULATORY GENES  
AND USES THEREOF**

PETITION TO WAIVE THE REQUIREMENT OF SECTION 1.52(e)

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

The undersigned hereby respectfully petitions the Commissioner or the Commissioner's designee to waive the requirements Section 1.52(e) relating to the electronic filing of an application in the U.S. Patent Office. The undersigned is petitioning for the waiver of this rule under Section 1.18(3) for the following reasons:

1. The present application as currently filed is a continuation of U.S. patent application 10/310,914, filed on December 9, 2002 (parent application).

2. The parent application as originally filed was quite large in size and scope and was filed containing both written documents as well as various disks of information.

3. Applicant has been endeavoring to comply to the Patent Office rules relating to the filing of electronic documents by submitting a continuation application utilizing the newly created electronic filing system (EFS).

4. Due to the unusually large size and scope of this continuation application, the EFS system was unable to process

the application either over the Internet or directly at the U.S. Patent Office due to a problem of parsing and decrypting the voluminous amount of data attempted to be filed using the EFS system. This problem was due in part to the software currently used by the EFS system.

5. To attempt to circumvent this problem, we have filed the continuation application in "native format" (i.e. Specification and Application Data Sheet in XML format, and large tables and sequence listing in ASCII format, rather than in the standard EFS format of the extremely large encrypted file.

6. At the suggestion of William Stryjewski and Jay Lucas of the U.S. Patent Office, the undersigned is submitting one CD-R of the continuation application as well as a copy of the continuation application on a second CD-R. It is important to note that the present application contains no new data over the previous parent application.

7. Each CD-R includes a first zip file containing all of the native XML files of the specification and application data sheet, a second zip file containing ASCII table files and a third zip file containing the ASCII file of the sequence listing of the present application.

8. Should the present petition be granted, the EFS Team will process the CD-R's into the EFS system.

9. Applicant will gladly work with the EFS Team in order to help them fine-tune the EFS system to handle the electronic filing of exceptionally large patent applications.

Since applicant has endeavored to utilize the EFS system to file a continuation application for the parent application and, due to no fault of their own, was unsuccessful in filing such an application, it is respectfully petitioned that the rules for electronic filing of application under Section

1.52(e) be waived at the present time to allow the filing of the present application in the manner as outlined hereinabove.

The undersigned has requested that the \$130.00 petition be deducted from Deposit Account No. 502830 as indicated in the Transmittal Letter accompanying the continuation application.

Respectfully submitted,



Mitchell B. Wasson  
Reg. No. 27,408  
HOFFMAN, WASSON & GITLER, P.C.  
2361 Jefferson Davis Highway  
Suite 522  
Arlington, VA 22202  
(703) 415-0100

August 29, 2003

**Attorney Docket No.: A-8330.C.PET/cat**

## **PATENT APPLICATION INFORMATIONAL LETTER**

Dear Sir:

Enclosed please find a patent application entitled **"BIOINFORMATICALLY DETECTABLE GROUP OF NOVEL REGULATORY GENES AND USES THEREOF"**, invented by inventor, **ITZHAK BENTWICH**.

This application is a continuation of U.S. patent application Serial No. 10/310,914, filed on December 9, 2002, titled identically to the title of the present application. It is hereby stated that the present application does not introduce any new material over the above-mentioned previous patent application.

Due to the extremely large size of the present application, and technical problems of EFS in handling (specifically of parsing and decrypting) applications of this size, and at the advice of Jay Lucas and Bill Stryjewski, the application is submitted to EFS on CD-R, in native format (XML and ASCII). At the request of Bill Stryjewski, and for the sake of simplicity, the files are zip-compressed.

The following related documents and computer disks are enclosed:

1. Patent Transmittal Letter and Power of Attorney documents.
2. A Petition for Waiver of 37 CFR 1.52, submitted on the advice of Jay Lucas and Bill Stryjewski.
3. A CD-R, submitted in two copies hereby stated to be identical duplicates, labeled "DISK 1 OF 2: SPECIFICATION, TABLES & SEQUENCE LISTING (COPY 1)" and "DISK 2 OF 2: SPECIFICATION, TABLES & SEQUENCE LISTING (COPY 2)" respectively, each containing: a specification of the present invention (in EFS- XML format); and large tables and sequence listing of the present invention (both in ASCII format). Each of the above is standard zip-compressed.




The CD-R disks are IS09660 CD-R computer compact-disks. The machine format of the disks is IBM-PC, and the operating system is MS-WINDOWS.

Both disks contain the following files:

<u>File Name</u>	<u>Size</u>	<u>Created</u>
spec.zip	10277 KB	08/29/03
tables.zip	82150 KB	08/29/03
sequence.zip	24437 KB	08/29/03

I hereby certify that the above is accurate.

Respectfully submitted,



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August 29, 2003

Attorney Docket No.: A-8330.C.PATL/cat